UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,850	02/14/2001	Steven Mark Gebert	8185P010	9299

76073   7590   01/21/2009
InfoPrint Solutions/ Blakely
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
01/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/782,850	GEBERT ET AL.
	Examiner	Art Unit	
	JOSHUA D. CAMPBELL	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>29 October 2008</u>.
2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>49-87</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>49-87</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.　　This action is responsive to communications: Amendment filed on 10/29/2008.

2.　　Claims 49-87 are pending in this case. Claims 49, 62, and 75 are independent claims. Claims 49, 62, and 75 have been amended.

Claim Rejections – Res Judicata

3.　　Claims 49-87 remain rejected on the grounds of *Res Judicata* based on a prior adjudication (see BPAI Decision mailed on January 23, 2008 affirming the examiner's rejection of claims 1, 2, 4, 8-11, 14-16, 18, 22-25, 28-30, 32, 36-39, and 42-48) against the inventor on patentably nondistinct claims involving the same issues. The limitations of claim 49 map to the patentably nondistinct limitations of previously rejected and adjudicated claim 1 as follows:

Previously rejected, appealed, and affirmed claim 1:	Newly filed claim 49 under 37 CFR 1.114:	Reasons limitations are patentably nondistinct:
A method for processing a source document in a structured document format including elements providing source content to render, wherein the source content comprises code that is rasterized into output, comprising:	A method for processing a source document in a structured document format including elements providing source content to render, wherein the source content comprises code that is rasterized into output, comprising:	Language repeated verbatim.
receiving the source document including the source content in a presentation language;	receiving the source document including the source content in a presentation language;	Language repeated verbatim.
receiving a layout data structure separate from the	receiving a layout data structure separate from the	Language repeated verbatim.

source document, providing formatting properties specifying a layout and format of the content output, wherein the layout data structure does not include source content;	source document, providing formatting properties specifying a layout and format of the content output, wherein the layout data structure does not include source content;	
processing the source document and the layout data structure to determine formatting properties, including page divisions, for the content in the source document;	processing the source document and the layout data structure to determine formatting properties, including page divisions, for the content in the source document;	Language repeated verbatim.
generating *multiple page objects* wherein each page object includes the source content in the presentation language used in the source document and the determined formatting properties *for one page,*	generating *a first page object* including the source content in the presentation language used in the source document and formatting properties *for only one page;* generating *a second page object* including the source content in the presentation language used in the source document and formatting properties *for a only second page,*	Claim 1 discusses generating "multiple page objects" that meet a certain criteria, while claim 49 discusses generating both "a first page object" and "a second page object" which meet the same criteria as the "multiple page objects" in claim 1. Clearly first and second objects (two existing objects of specific criteria) are nondistinct from multiple objects (two or more objects of the same specific criteria) each of which contain content and formatting for one page.
wherein *at least one page object* has multiple content elements, and wherein the content elements include content to place on the pages; and	wherein *the first page object* includes a first set of content elements to place on the first page and *the second page object* includes a second set of content elements to place on the second page; and	Claim 1 discusses that "at least one page object" (1 or more) has multiple content elements to place on the page. Claim 49 discusses "the first page object" has a first set of content elements (multiple content elements) to place on the first page and "the second page object" has a

		second set of content elements (multiple content elements) to place on the second page. The only difference in the claims is that claim 1 states that "at least one page object" meets specific criteria, while claim 49 states that a first and second object meet the same specific criteria. However, it is clear that two objects of a specific criteria are patentably nondistinct from one or more objects (which by definition would include two) of the same specific criteria.
transmitting **the page objects** to a rasterizer to transform into renderable information capable of being generated by an output device.	transmitting **the first page object and the second page object** to a rasterizer to transform into renderable information capable of being generated by an output device.	Claim 1 discusses transmitting "the page objects" to a rasterizer, claim 49 discusses transmitting "the first page object and the second page object" to a rasterizer. Again, clearly first and second objects (two existing objects of specific criteria) are nondistinct from the page objects (two or more objects of the same specific criteria).

Independent claims 62 and 75 are substantially similar to claim 49, and are considered to be patentably nondistinct of claims 15 and 29 of the previously appealed claims for the same reasons has claim 49 when compared to claim 1 of the previously appealed claims.

Dependent claims 50-61 are considered to be patentably nondistinct of claims 2, 4-11, 14, 43, and 44 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Dependent claims 62-74 are considered to be patentably nondistinct of claims 16, 18-25, 28, 45, and 46 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Dependent claims 76-87 are considered to be patentably nondistinct of claims 30, 32-39, 42, 47 and 48 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Thus, all of the currently pending claims as filed are rejected on the grounds of *Res Judicata* based on a prior adjudication against the inventor on patentably nondistinct claims involving the same issues, in effect barring the examiner from issuing these claims.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 75-87 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are non-statutory for at least the reason that they are not properly embodied so as to be executable (i.e. stored on a computer readable storage medium which does not include a carrier wave or other form of transmission medium). Based on the definitions found in the

specification (see page 13, lines 10-17 of applicant's specification), a computer

readable medium is non-statutory. The examiner recommends amending the claims to

state, "An article of manufacture, in communication with an output device, comprising a

<u>computer readable non-volatile storage unit</u> for processing…" in order to overcome the

rejection. Proper correction is required.

Claim Rejections - 35 USC § 103

5.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

6.   Claims 49-56, 60-69, 73-81 and 85-87 remain rejected under 35 U.S.C. 103(a)

as being unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet

Language (XSL) Version 1.0, published on October 18, 2000) in view of Saito et al.

(hereinafter Saito, US Patent Number 5,323,312, issued on June 21, 1994).

      Regarding independent claim 49, Adler discloses a method in which a source

document including source content is received in XML (pages 17-18, section 1.1

Processing a Stylesheet). Then, a layout data structure (XSL stylesheet) which

provides formatting properties and is separate from the source document and does not

contain source content is received (pages 17-18, section 1.1 Processing a Stylesheet).

The two documents are processed together and to determine formatting, including page

divisions, of the source content (pages 20-21, Section 1.1.2 Formatting and pages 25-

27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout

Model). Adler also discloses a method in which multiple page objects are generated by

filling the XML content into "containers", each of the objects containing the content and

the information required to format the content for one page, at which point the

"containers" are rasterized into page instances which are capable of being generated by

an output device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section

1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model). Adler

discloses that the page objects include the content that is to be placed on the pages,

Adler does not explicitly state that the content consists of multiple content elements.

However, Saito discloses that it was well known in the art that a structured document

could consist of two parts a layout structure and a logical structure (source content), and

when filling the page objects defined by the layout structure more than one content

object from the logical structure could be used, thus allowing more than one content

object to exist within each page object (column 1, lines 31-57 of Saito). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have used the method of Adler with the well-known material disclosed by Saito because

it would have allowed the space in visible pages to be used completely by filling page

objects with more than content object where it was warranted.

 Regarding dependent claims 50, Adler discloses a method in which page

divisions may be presented in XSL-FO, which is a device independent language (pages

20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling

and Section 1.2.3 An Extended Page Layout Model).

 Regarding dependent claim 51, Adler discloses a method in which a page

description language is used (pages 17-18, section 1.1 Processing a Stylesheet).

Regarding dependent claim 52, Adler discloses a method in which the source document does not indicate page divisions (pages 17-18, section 1.1 Processing a Stylesheet).

Regarding dependent claims 53 and 54, Adler does not explicitly disclose that a page object is filled with content objects until there is no more space, then the next page element is filled with the sequential content objects, or that page sequence elements exist in which the content is accessed in sequence and added to the page objects accordingly. However, Saito discloses that it was well known in the art that a structured document could consist of two parts a layout structure and a logical structure (source content in the logical page viewing sequence), and when filling the page objects defined by the layout structure more than one content object from the logical structure could be used per page until a page is full at which point the next page object is filled with content and so forth (column 1, lines 31-57 of Saito). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of Adler with the well-known material disclosed by Saito because it would have allowed the space in visible pages to be used completely by filling page objects before moving on to filling the next sequential page object.

Regarding dependent claims 55 and 56, Adler also discloses a method in which the source document (XML) and the result document (XSL-FO) may be different formats, and the result document is formatted based on the layout data structure (XSL) (pages 17-18, section 1.1 Processing a Stylesheet and pages 20-21, Section 1.1.2 Formatting). Adler also discloses a method in which multiple page objects are

generated by filling the XML content into "containers", each of the objects containing the content and the information required to format the content, at which point the "containers" are rasterized into page instances which are capable of being generated by an output device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).

Regarding dependent claims 60 and 61, Adler discloses a method in which page divisions may be presented in XSL-FO, which is a device independent language (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).

Regarding independent claim 62 and dependent claims 63-69, 73 and 74, the claims incorporate substantially similar subject matter as claims 49-56, 60, and 61. Thus, the claims are rejected along the same rationale as claims 49-56, 60, and 61.

Regarding independent claim 75 and dependent claims 76-81 and 85-87, the claims incorporate substantially similar subject matter as claims 49-56, 60, and 61. Thus, the claims are rejected along the same rationale as claims 49-56, 60, and 61.

7.   Claims 57, 59, 70, 72, 82, and 84 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet Language (XSL) Version 1.0, published on October 18, 2000) in view of Saito et al. (hereinafter Saito, US Patent Number 5,323,312, issued on June 21, 1994) as applied to claims 55, 68, and 80 above, and further in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999).

Regarding dependent claim 57, 59, 70, 72, 82, and 84, Adler does not disclose page objects which are in a third presentation language which is a page description language. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page in a different page description language (image bit-map) (column 1, line 24- column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Adler with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

8.   Claims 58, 71, and 83 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet Language (XSL) Version 1.0, published on October 18, 2000) in view of Saito et al. (hereinafter Saito, US Patent Number 5,323,312, issued on June 21, 1994) further in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999) as applied to claims 57, 70, and 82 above, and further in view of Sall (as found in the IDS - FOP: Formatting Object to PDF Translator (James Tauber, published in 1999).

Regarding dependent claims 58, 71, and 83, Adler also discloses a method in which the source document (XML) and the result document (XSL-FO) may be different formats, and the result document is formatted based on the layout data structure (XSL) (pages 17-18, section 1.1 Processing a Stylesheet and pages 20-21, Section 1.1.2 Formatting). Adler also discloses a method in which multiple page objects are

generated by filling the XML content into "containers", each of the objects containing the

content and the information required to format the content, at which point the

"containers" are rasterized into page instances which are capable of being generated by

an output device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section

1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model). Adler

does not disclose a method in which the language of the page objects is MO:DCA, a

common presentation imaging language. However, Sall discloses a method in which an

XML is converted to XSL-FO based on an XSL stylesheet, then based on XSL-FO

convert the document to a PDF (pages 1-2 of Sall), which as defined in 1998 by

McCalpin (page 3 of "Traditional Electronic Printing on the Internet") as being an

common analogous presentation language to MO:DCA. It would have been obvious to

one of ordinary skill in the art at the time the invention was made to have combined

Adler with methods taught by Sall because this method was noted to be a potential

replacement for typical desktop published due to formatting advantages.

Response to Arguments

9.   Applicant's arguments filed 10/29/2008 have been fully considered but they are

not persuasive.

        Regarding applicant's arguments on page 12, in reference to the rejection on the

grounds of Res Judicata, the examiner respectfully disagrees and the rejection has

been maintained. The applicant states that the Board of Patent Appeals and

Interferences (hereinafter BPAI) ruled that a page object has previously claimed

contained the content and formatting properties for "one or more pages," and thus changing the claim limitation to clarify that a page object contains the content and formatting for "only" one page object. However, this does not distinguish the current claims from the previously adjudicated claims. The phrase "one or more" is not patentably distinct from the phrase "only one" based solely on the literal meanings of the two phrases. The phrase "one or more" provides the limitation of having at least one of the specific criteria and does not require the existence of any more than that one, thus having "only one" would fall into the definition of the phrase "one or more" which is the reason that the slight change in the language of the claim limitation does not distinguish the current claims from the previously appealed claims.

Regarding applicant's arguments on pages 14-15, in reference to a page object having the content and formatting for only one page, the examiner maintains that Adler discloses the limitations it was previously and is currently worded, thus the rejection has been maintained. Adler discloses that a result tree is generated by processing the XSL document (layout data structure) and the source tree (source content) (page 18, Final Paragraph and Figure of Adler). Adler explicitly discloses that the result tree consists of objects in the "formatting object" namespace (page 18, Final Paragraph). Adler teaches that, "Formatting semantics are expressed in terms of a catalog of classes of formatting objects. The nodes of the result tree are formatting objects. The classes of formatting objects denote typographic abstractions such as *page*, paragraph, table, and so forth," (page 18, first paragraph, lines 1-4 of Adler). Adler also teaches that the formatting objects are represented as XML elements with the properties and attributes of the XML

value pairs and the content of the original XML element (i.e. original source content)

(page 18, Final Paragraph of Adler). This process is more clearly explained using the

figure on Page 19, which shows the source tree (original XML content) is transformed

using XSL stylesheet, which represents the formatting information for the XML content.

This process creates the result tree which has formatting objects for nodes which

included the original XML content and formatting information necessary to properly

display the content. In other words, the result of processing the source content and the

layout data structure is a result tree. This result tree consists of formatting objects

which correspond to typographic abstractions such as pages, also known as "page

objects," if the document being processed consisted of more than one page of data the

result tree would be required to have multiple page objects. These objects are stand-

alone abstractions which contain both the formatting and the content necessary for each

typographic abstraction, once again in this case that would be only one page.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
January 6, 2009